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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,039	08/09/2000	Jamey Graham	15358-004240US	5597
20350	7590	02/12/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			CAMPBELL, JOSHUA D	
			ART UNIT	PAPER NUMBER
			2178	
DATE MAILED: 02/12/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/636,039	GRAHAM ET AL.
	Examiner	Art Unit
	Joshua D Campbell	2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 August 2000.
2a) This action is FINAL. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-41 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-41 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 09 August 2000 is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4-9.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .
5) Notice of Informal Patent Application (PTO-152)
6) Other: ____ .

DETAILED ACTION

1. This action is responsive to communications: Application filed on 08/09/2000.
2. Claims 1-41 are pending in this case. Claims 1, 11, 19, 20, 30, and 38-41 are independent claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3, 6-8, 20, 22, and 25-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Okamoto et al. (hereinafter Okamoto, US Patent Application Publication 2002/0065814, US filing date June 30, 1999).

In regard to independent claim 1, Okamoto discloses a method in which a document is accessed and it is searched to identify text patterns that are relevant to user queries (plurality of concepts) (page 2, paragraphs 0028-0035 of Okamoto). The text patterns that match the queries are then marked using tags and highlighted

(annotated) to emphasize their position as the document is viewed (page 11, paragraph 0245-0255 of Okamoto).

In regard to dependent claim 3, Okamoto discloses a method in which search terms are supplied via user queries and a document is searched to identify text patterns that match those search terms (page 2, paragraphs 0028-0035 of Okamoto).

In regard to dependent claims 6-8, Okamoto discloses a method in which tags are inserted into the document surrounded relevant text that identify what query the tag is in response to, by both tag id and color/style of the highlight that is set to correspond to each specific query (page 11, paragraph 0245-0255 of Okamoto).

In regard to independent claim 20 and dependent claims 22 and 25-27, the claims incorporate substantially similar subject matter as claims 1, 3, and 6-8. Thus, the claims are rejected along the same rationale as claims 1, 3, and 6-8.

5. Claims 11-13, 17-18, 30-32, and 36-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Rowe et al. (US Patent Number 5,737,599, issued on April 7, 1998 - IDS).

In regard to independent claim 11, Rowe discloses a method in which a multi-page document is accessed and a section of that document is shown in a first area and thumbnails of the entire document are displayed in a second area (Figure 2b and column 12, lines 26-36 of Rowe). Rowe also discloses a method in which information about the contents of a document, including dimensions and locations of items (coordinates) are determined (Figure 15a-d and column 37, line 10-column 41, line 11

of Rowe). Rowe also discloses that the portion of the thumbnail window corresponding to the part of the document being displayed is highlighted (emphasized) (column 12, lines 26-36 of Rowe).

In regard to dependent claim 12, Rowe discloses a method in which information about the contents of a document, including dimensions and locations of items (coordinates) are determined so that when a portion of the thumbnail window is selected the correct section of the document can be downloaded for display (Figure 2b and column 12, lines 26-36 of Rowe).

In regard to dependent claim 13, Rowe discloses a method in which document correspondence between thumbnail and full image is based on a denominator used to divide the page contents (Figure 15a-d and column 37, line 10-column 41, line 11 of Rowe).

In regard to dependent claim 17, Rowe discloses a method in which determining information about a document (coordinates and dimension) for creating thumbnail representations of the document incorporate all formatting of that document including forms (column 11, line 66-column 12, line 36 of Rowe).

In regard to dependent claim 18, Rowe discloses a method in which determining information about a document (coordinates and dimension) includes determining information about text, forms, graphics, images, and links (column 11, line 66-column 12, line 36 of Rowe).

In regard to independent claim 30 and dependent claims 31-32 and 36-37,
the claims incorporate substantially similar subject matter as claims 11-13 and 17-18.
Thus, the claims are rejected along the same rationale as claims 11-13 and 17-18.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 2, 5, 21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto et al. (hereinafter Okamoto, US Patent Application Publication 2002/0065814, US filing date June 30, 1999) as applied to claims 1 and 20

above, and further in view of Gonares et al. (hereinafter Gonares, US Patent Number 6,681,370, filed on May 19, 1999).

In regard to dependent claims 2 and 21, Okamoto does not disclose a method in which the searching and marking of the document is performed using a Document Object Model configured by Internet Explorer. However, Gonares discloses a method in which a document that is converted into a Document Object Model tree using a web browser (i.e. Internet Explorer) to make changes to specific locations in a document by finding the location (searching) and editing the location (marking) (column 2, line 63-column 4, line 27 of Gonares). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of searching a document of Okamoto with the method of using a DOM tree to edit a document of Gonares because it would have provided a set standard of modeling, interfacing and manipulating the documents that are being marked.

In regard to dependent claims 5 and 24, Okamoto does not disclose a method in which the searching and marking of the document is performed using IMarkupServices interface configured by Internet Explorer. However, Gonares discloses a method in which a document that is converted into a Document Object Model tree using a web browser (i.e. Internet Explorer) to make changes to specific locations in a document by finding the location (searching) and editing the location (marking) (column 2, line 63-column 4, line 27 of Gonares). Gonares also discloses that IMarkupServices interface is used to insert tags into the document to edit the appearance (mark) (column 10, lines 8-59 of Gonares). It would have been obvious to

one of ordinary skill in the art at the time the invention was made to have combined the method of searching a document of Okamoto with the method of using a DOM tree with IMarkupServices to edit a document of Gounares because it would have provided a set standard of modeling, interfacing and manipulating the documents that are being marked.

9. Claims 4 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto et al. (hereinafter Okamoto, US Patent Application Publication 2002/0065814, US filing date June 30, 1999) as applied to claims 1 and 20 above, and further in view of msdn online Web Workshop (published online on April 20, 2000).

In regard to dependent claims 4 and 23, Okamoto does not disclose a method in which IHTMLTxtRange Interface is used to perform the searching and marking of a document. However, msdn Online Web Workshop discloses that the IHTMLTxtRange interface is used to retrieve and modify text in an element, locate specific strings in the text, and carry out commands that affect the appearance of the text (i.e. search and mark) (Remarks Section of msdn Online Web Workshop). It would have been obvious to one of ordinary skill in the art to combine the method of searching of Okamoto with the method of searching and marking disclosed by msdn Online Web Workshop because it would have allowed for a simple interface to search and modify both plain text and HTML.

10. Claims 9-10 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto et al. (hereinafter Okamoto, US Patent Application Publication 2002/0065814, US filing date June 30, 1999) as applied to claims 1 and 20 above, and further in view of Schultz (US Patent Number 5,721,902, issued on February 24, 1998).

In regard to dependent claims 9 and 10, Okamoto does not disclose a method in which scores are calculated for the concepts in a document based on a frequency of text patterns that are relevant to the specific concepts. Okamoto also does not disclose a method in which a relevance indicator is displayed based on relevance score calculations. However, Schultz discloses a method in which relevance scores are determined based on the frequency that the query terms appear in a document (column 25, line 5-column 26, line 20 of Schultz). Schultz also discloses that a graphical representation providing the results or the relevance scoring is provided to the user (column 25, line 5-column 26, line 20 of Schultz). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of searching by Okamoto with the method of ranking relevance of a document based on search terms by Schultz because it would have provided a user with a visual representation of the relevance of a document to the query terms.

In regard to dependent claims 28 and 29, the claims incorporate substantially similar subject matter as claims 9 and 10. Thus, the claims are rejected along the same rationale as claims 9 and 10.

11. Claims 14-16 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe et al. (US Patent Number 5,737,599, issued on April 7, 1998) as applied to claims 11 and 30 above, and further in view of Okamoto et al. (hereinafter Okamoto, US Patent Application Publication 2002/0065814, US filing date June 30, 1999).

In regard to dependent claim 14, Rowe discloses a method in which information (coordinates and dimension) about objects in a document (text, graphics, images, and links) are determined (column 11, line 66-column 12, line 36 of Rowe). Rowe does not disclose that text entities are annotated according to style information if they are relevant to any of a plurality of concepts. However, Okamoto discloses a method in which a document is accessed and it is searched to identify text patterns that are relevant to user queries (plurality of concepts) (page 2, paragraphs 0028-0035 of Okamoto). The text patterns that match the queries are then marked using tags and highlighted (annotated) to emphasize their position as the document is viewed (page 11, paragraph 0245-0255 of Okamoto). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Rowe with the method of searching a document by Okamoto because it would have provided a user with a simple way to search and identify terms when viewing a document.

In regard to dependent claim 15, Rowe discloses a method in which the thumbnail representations of the document incorporate all formatting of that document

which would include highlighted text entities (column 11, line 66-column 12, line 36 of Rowe).

In regard to dependent claim 16, Rowe does not disclose a method in which the style information relevant to a concept is modified and in response all entities that correspond to that concept are changed to correspond with the new style information. However, Okamoto discloses a method in which a concept tag number, which corresponds to one of a plurality of concepts, is directly associated with a specific style (page 12, paragraph 0270-0276 of Okamoto). When that style information is changed all tags corresponding to the tag number associated with that style information will reflect that change (page 12, paragraph 0270-0276 of Okamoto). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Rowe with the method of searching a document by Okamoto because it would have provided a user with a simple way to search and customize the identification of terms when viewing a document.

In regard to dependent claims 33-35, the claims incorporate substantially similar subject matter as claims 14-16. Thus, the claims are rejected along the same rationale as claims 14-16.

12. Claims 19 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe et al. (US Patent Number 5,737,599, issued on April 7, 1998) in view of Okamoto et al. (hereinafter Okamoto, US Patent Application Publication 2002/0065814, US filing date June 30, 1999).

In regard to independent claim 19, Rowe discloses a method in which a multi-page document is accessed and a section of that document is shown in a first area and thumbnails of the entire document are displayed in a second area (Figure 2b and column 12, lines 26-36 of Rowe). Rowe also discloses a method in which information about the contents of a document, including dimensions and locations of items (coordinates) are determined (Figure 15a-d and column 37, line 10-column 41, line 11 of Rowe). Rowe also discloses that the portion of the thumbnail window corresponding to the part of the document being displayed is highlighted (emphasized) (column 12, lines 26-36 of Rowe). Rowe does not disclose that text entities are annotated according to style information if they are relevant to any of a plurality of concepts. However, Okamoto discloses a method in which a document is accessed and it is searched to identify text patterns that are relevant to user queries (plurality of concepts) (page 2, paragraphs 0028-0035 of Okamoto). The text patterns that match the queries are then marked using tags and highlighted (annotated) to emphasize their position as the document is viewed (page 11, paragraph 0245-0255 of Okamoto). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Rowe with the method of searching a document by Okamoto because it would have provided a user with a simple way to search and identify terms when viewing a document.

In regard to independent claims 38-41, the claims incorporate substantially similar subject matter as claim 19. Thus, the claims are rejected along the same rationale as claim 19.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent Number 5,806,079, by Rivette et al.

US Patent Number 6,131,092, by Masand.

US Patent Number 6,553,373, by Boguraev.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (703)305-5764. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703)308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JDC
February 5, 2004



STEPHEN S. HONG
PRIMARY EXAMINER